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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3714

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/612,419
Applicants : Joel R. Jaffe
William R. Wadleigh
Filed : July 2, 2003
Title : Award Display For Gaming Machine Having Extendable and
Retractable Elements

TC/A.U. : 3714
Examiner : Tramar Yong Harper
Docket No. : 247079-000212USPT
Customer No. : 70243

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 22, 2007

Signature:

Christine Pisarski

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Commissioner:

The Final Office Action was mailed on January 22, 2007 and an Advisory Action was mailed on April 12, 2007 which refused entry of an Amendment and Response filed on March 22, 2007. An Interview was conducted with Examiner Harper and Examiner Coburn on March 13, 2007. The shortened time period to respond to the Final Office Action is therefore April 22, 2007. This Pre-Appeal Brief Request for Review is being filed on May 22, 2007, together with a Petition for Extension of Time and Notice of Appeal.

Claims 1-3, 7-11, 16, 18-20, and 24-25 stand rejected under 35 U.S.C. 102(e) as being anticipated by US 2003/0064806 (“Gordon”). Claims 1-2, 4, 6-10, 12, 14, 16, 18-19, 21, and 23-25 also stand rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0053687 (“Nordman”).

A. Claims 1, 9 and 18 Are Not Anticipated By Gordon Or Nordman

Independent claims 1, 9 and 18 generally relate to a gaming apparatus having an electro-mechanical award display. The award display includes a plurality of physical elements each located at a different location on the housing and movable between an extended position and a retracted position to indicate a game outcome.

1. Gordon Does Not Disclose Physical Elements That Indicate A Game Outcome

Gordon is primarily related to a system to interconnect gaming machine components. One example of a game in Gordon is a cuckoo clock themed game as shown in Figure 5. The Final Office Action has cited Figure 5 of Gordon for a plurality of physical elements in the form of “cuckoo” birds moveable between a retractable and extendable position. However, Gordon does not disclose any details of the function of the cuckoo birds in relation to the game outcomes. In the interview, the Examiner further pointed out that the doors in the Gordon cuckoo clock also are moveable between a retractable and extendable position. As with the cuckoo birds, Gordon does not disclose any function of the doors in relation to a game outcome. Gordon’s description of the elements in Figure 5 does not discuss either of these physical elements indicating a game outcome via movement between the extended and retracted position. Since there is no disclosure or suggestion in Gordon that the physical elements (either the

“cuckoo” birds or the doors) have any function relating to indicating a game outcome, claims 1, 9 and 19 are allowable over Gordon.

2. Nordman Does Not Have Physical Elements Moveable Between An Extended Position and A Retracted Position

The Final Office Action has cited Nordman as showing an electro-mechanical display which includes a plurality of octopus legs moving between a retractable and extendable position. Fig. 11 of Nordman discloses an octopus having arms which may be moved on tracks on a board. However, Nordman does not disclose physical elements which extend toward and retract away from a player. Further the octopus arms in Nordman themselves do not indicate a game outcome. Nordman therefore does not anticipate claims 1, 9 and 19.

B. Claims 3-4, 11-12 And 20-21 Are Allowable Over Nordman And Gordon Because Neither Reference Has An Extended Or Retracted Position Flush With A Panel

Claims 3-4, 11-12 and 20-21 all require the physical elements to have an extended position or a retracted position that are flush with a panel. Nordman does not disclose physical elements which move for example between an extended position toward from the player and a retracted position away from the player such that one of those positions is flush with a backing panel. The octopus arms in Nordman only move on the back panel on the tracks on which they are mounted and thus the arms are always on top of the panel, the octopus arms never move to a position flush with the panel. Claims 3-4, 11-12 and 20-21 which all require either the extended position or retracted position to be flush with the panel are thus allowable over Nordman.

Similarly, such elements are allowable over Gordon as the cuckoo birds are also never flush with the panel because they are multi-dimensional objects and therefore cannot be flush

with the backing panel. Further as explained above Gordon's cuckoo birds and doors do not indicate a game outcome.

These claims are allowable because neither Gordon nor Nordman disclose physical elements which are either approximately flush with the panel in the extended or retracted position.

C. Claims 16 and 25 Are Allowable Because The Physical Elements in Gordon and Nordman Are Not Associated With Respective Game Outcomes

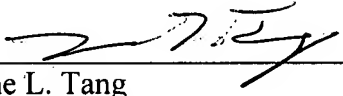
Claims 16 and 25 require "the physical elements are associated with respective outcomes." Neither the octopus arms in Nordman or the cuckoo birds or doors of Gordon are associated with the outcomes of the games. As such claims 16 and 25 are separately allowable over both Gordon and Nordman. The Examiner acknowledged neither the octopus arms in Nordman, nor the "cuckoo" birds in Gordon, show indicia of game outcomes in the Interview. As is clear, the outcomes of the games are not indicated by the octopus arms of Nordman which do not have any numerical or other indicators. At best, the octopus arms in Figure 11 of Nordman point to scores which are printed on the back panels. The game outcomes are not associated with the physical elements themselves. Gordon's cuckoo birds and doors also do not have any indicators of game outcomes either. In contrast, claims 16 and 25 require that the physical elements themselves are associated with game outcomes. For example, as shown in Figure 1 of the specification, the physical elements have numbers on them thus associating them with game outcomes. Since neither Gordon nor Nordman disclose physical elements associated with respective outcomes in and of themselves, claims 16 and 25 are allowable.

D. Conclusion

The pending claims relate to game indicator mechanisms that are differ from Gordon and Nordman. As such, Applicant request that these claims be allowed.

Respectfully submitted,

Date: May 22, 2007



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